LIBRARY
SUPREME COURT, U. S.

351

Office-Supreme Court, U.S.
FILED
JUL 29 1968
JOHN F. DAVIS, CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1968

MIKE ROBERTS COLOR PRODUCTIONS, INC.,
Petitioner

vs.

COLOURPICTURE PUBLISHERS, INC.,
Respondent

Petition for a Writ of Certiorari to the United States Court of Appeals for the First Circuit

EDWARD B. GREGG
483 Mills Building
San Francisco, California 94104

Attorney for Petitioner

Of Counsel

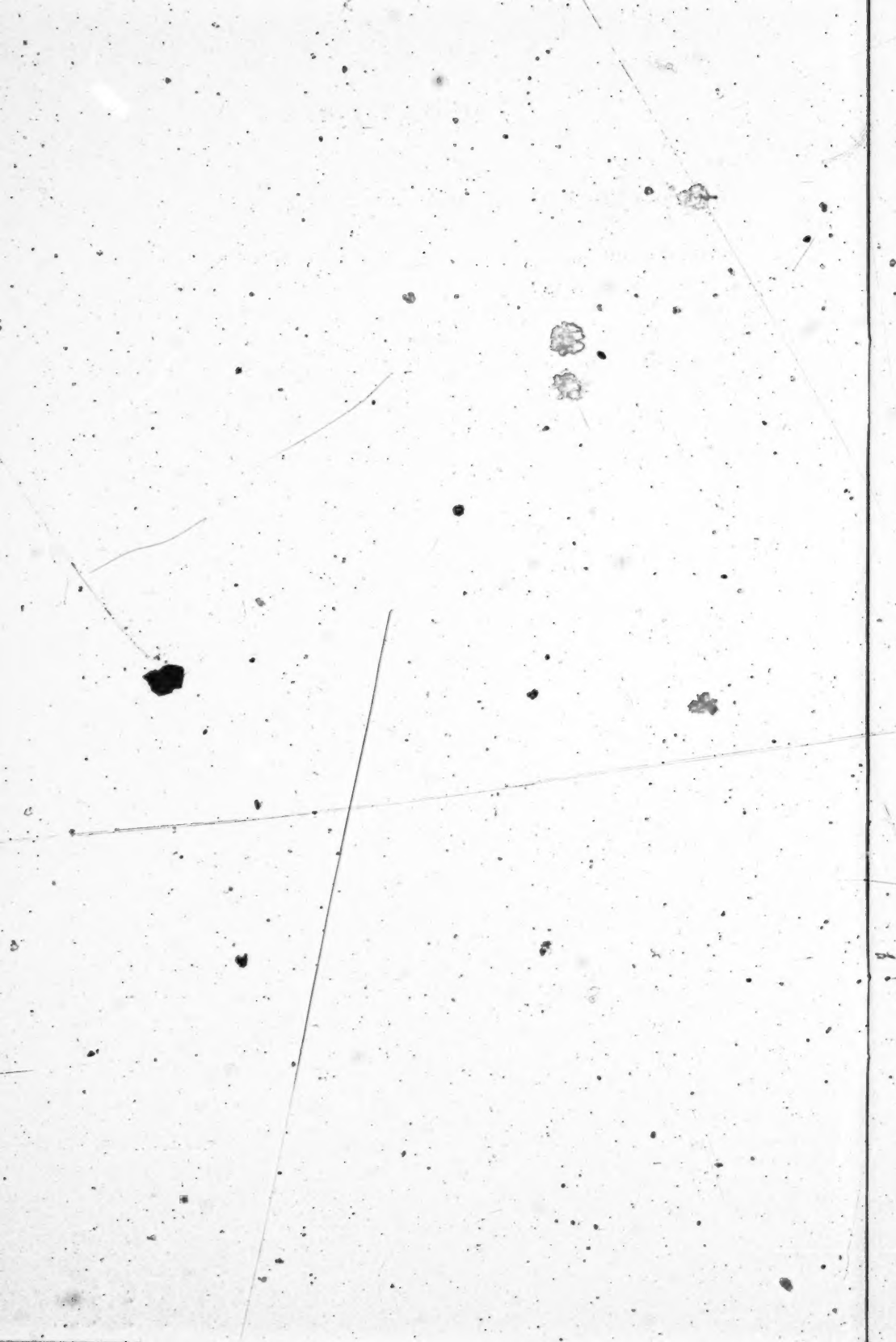
LIPPINCOTT, GREGG, HENDERSON & STIDHAM
483 Mills Building
San Francisco, California 94104

KENWAY, JENNEY & HILDRETH
24 School Street
Boston, Massachusetts 02108

WILLIAM G. MACKAY
155 Montgomery Street
San Francisco, California 94104

PAUL L. MAY
1939 Harrison Street
Oakland, California 94612

SORG PRINTING COMPANY OF CALIFORNIA, 346 FIRST STREET, SAN FRANCISCO 94105



SUBJECT INDEX

	Page
Opinions Below	1
Jurisdiction	2
Questions Presented	2
Statutory Provisions Involved	2
Statement of the Case	3
Subject Matter of the Tichnor Patent	3
The State of the Prior Art	4
The Novelty (If Any) of the Tichnor Patent	8
The Summary Judgment of the District Court	8
The Reversal by the Court of Appeals	10
Reasons Why the Writ Should Be Granted	11
Conclusion	16
Appendices	
Opinion of the Court of Appeals	1a
Judgment of the Court of Appeals	8a
Opinion of the District Court	9a
Publicity Concerning the Court of Appeals Decision Promulgated by Respondent	14a

TABLE OF AUTHORITIES CITED

Cases	Pages
Alladin Plastics, Inc. v. Jerrold Stephan Co., 362 F.2d 532 (9th Cir. 1966)	15
Allen-Bradley Co. v. Air Reduction Co., 391 F.2d 282 (3rd Cir. 1968)	16
Graham v. John Deere, 383 U.S. 1	2, 12, 13, 14, 15, 16
Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147, 156 (1950)	12, 13
Monoplastics, Inc. v. Caldor, Inc., 378 F.2d 20 (2nd Cir. 1967)	15
Walker v. General Motors, 362 F.2d 56, (9th Cir. 1966)	11, 15, 16

Statutes	
Federal Rules of Civil Procedure, Rule 56	2, 3, 8, 12, 13, 14, 15
28 U.S.C.:	
§ 1254(1)	2
§ 1338(a)	2
35 U.S.C.:	
§ 101 and 102	11
§ 102(b)	8
§ 103	2, 9, 11, 12

Texts	
Moore, Federal Practice, 2nd Ed. Vol. 6, pp. 2057, 2613-2617	13
Mayer, "The Lawyers", pp. 400-401	13

In the Supreme Court of the United States

OCTOBER TERM, 1967

MIKE ROBERTS COLOR PRODUCTIONS, INC.,
Petitioner

vs.

COLOURPICTURE PUBLISHERS, INC.,
Respondent

Petition for a Writ of Certiorari to the United States Court of Appeals for the First Circuit

---

Petitioner, Mike Roberts Color Productions, Inc., prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the First Circuit in the above-entitled case.

OPINIONS BELOW

The opinion of the Court of Appeals is reported at 394 F2d 431; 157 USPQ 659, and is reprinted in Appendix I, p. 1a, *infra*. The opinion of the District Court for the District of Massachusetts is reported at 272 F. Supp. 280, and is reprinted in Appendix III, p. 9a, *infra*.

JURISDICTION

The judgment of the Court of Appeals was made and entered on May 8, 1968 (Appendix II, p. 8a, *infra.*) The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1). The basis of jurisdiction in the District Court was 28 U.S.C. § 1338(a).

QUESTIONS PRESENTED

1. Did this Court, in *Graham v. John Deere,* 383 U.S. 1, intend to hold that "the hazards"[1] of Rule 56 (summary judgment) of the Federal Rules of Civil Procedure are increased and that, in addition to the general requirements of Rule 56, "specific inquiries [are] exacted"[1] in any patent case where the question of obviousness is the issue?

2. Is the traditional function of Rule 56 in terminating litigation at any early stage abrogated by *Graham* in Section 103[2] patent cases, even where the patented device is very simple and easily understood and where the defense of obviousness is based upon the admitted state of the prior art, if the patentee alleges unobviousness and says that he will bring witnesses into court to testify to that effect?

3. Is it the intended result of *Graham* to require District Courts to refrain from rectifying clear error by the Patent Office in applying the Constitutional standard of invention until there has been a trial of the issue of obviousness?

STATUTORY PROVISIONS INVOLVED

One statute (35 U.S.C. 103) and one rule (Rule 56 (c), Federal Rules of Civil Procedure) are involved. These read as follows:

---

1. The quoted matter is from the opinion of the Court of Appeals, 394 F2d at 435, 157 USPQ at 662, Appendix I at 7a.

2. 35 U.S.C. 103.

35 U.S.C. 103: "A patent may not be obtained though the invention is not identifically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Rule 56(c): "The motion [for summary judgment] shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages."

STATEMENT OF THE CASE

This is a patent suit brought by Respondent against Petitioner for infringement of Tichnor U.S. Patent No. 3,259,304 (hereinafter referred to as Tichnor patent) entitled "Postcards".

Subject Matter of the Tichnor Patent

The Tichnor patent, aptly described by the Court of Appeals as one of "provokingly irresistible simplicity", is for a strip or sheet of several picture postcards arranged for simultaneous display of the pictures and having a top

card or panel with a hole in it so that it can be suspended from a hook for display. This top card or panel may have advertising printed on it.

This simple structure is reproduced from the drawings of the Tichnor patent on page 5 of this Petition. See also Record Appendix to Brief for Appellant, page 35. (This part of the record will be referred to as Record Appendix.) Figure 1 illustrates the front or pictorial side of the strip or sheet and Figure 2 illustrates the back or message side of the strip or sheet. The panel 15 at the top is formed with a hole 17 for suspending the sheet or strip of cards from a hook. Pl's Exhibit 2 (a physical exhibit) is a specimen of Respondent's (the patentee's) actual product sold under the Tichnor patent. A specimen of Petitioner's sheet or strip of picture postcards which is alleged to infringe the Tichnor patent is reproduced in Record Appendix at page 81 (front side) and 82 (back side). Pages 81 and 82 of the Record Appendix, although marked thereon as "Exhibit C", are actually parts of Pl's Exh. 6, Request for Admissions, Record Appendix 75.

The State of the Prior Art

The Tichnor patent itself sets forth certain pertinent background and prior art. At column 1, commencing at line 15, the patent says

> "Such [picture post] cards are often produced by lithographing or otherwise reproducing scenic or other graphic illustrations on one side of a large sheet and printing informational material on the rear side. The sheet is then divided as by cutting at the factory to form individual cards." (Matter in brackets added)

This is to say, the Tichnor patent acknowledges that it is old to manufacture picture postcards in sheets with the

July 5, 1966 L. F. TICHNOR 3,259,304

POSTCARDS

Filed May 25, 1965

FIG. 1

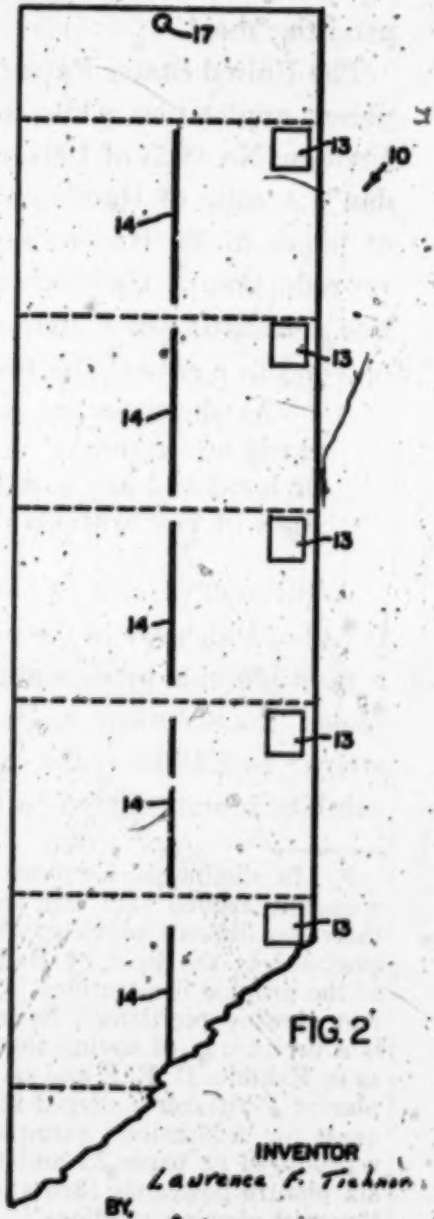


FIG. 2

INVENTOR
Laurence F. Tichnor

BY
Wolf, Greenfield & Hutz

ATTORNEYS

pictures on one side and informational material on the other side. What the Tichnor patent adds to these old sheets is a top panel with advertising material and with a hole to suspend the sheet.

The United States Patent Office cited against the Tichnor patent application, while it was pending, a British patent, Haddan, No. 9023 of 1904, referred to hereinafter as "Haddan". A copy of Haddan appears in the Record Appendix at pages 57-59. Haddan's structure is an album (see the reproduction of Haddan's drawing on page 7 of this Petition) consisting of a strip of picture postcards attached at one end to a cover. The text of Haddan at lines 10-12 says

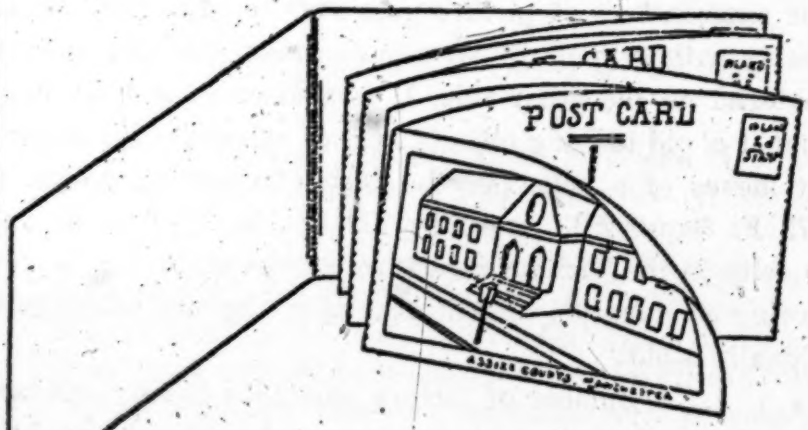
> "As shown in the annexed drawing a series of postcards are arranged in the form of a continuous strip or band and are merely separated from each other by lines of perforations."

Additionally, each of Defendants' Exhibits D, E, F and G (all of which are in the record as physical exhibits) shows a multiple side-by-side arrangement (rather than an end-to-end arrangement as in Haddan) of picture cards in strips.[3] In Exhibit G the cards are picture postcards. These exhibits are stipulated to be samples of devices on sale in

---

3. In distinguishing from Haddan in the Patent Office, Respondent argued that the postcards of Haddan are end-to-end, therefore difficult to view, whereas the claims of Respondent, as amended in the light of Haddan, specify that "substantially all of the graphic illustrations [are] presented to the eye in their correct viewing positions". Record Appendix pages 44 and 46. This is a prolix way of saying that the cards are arranged side-by-side, as in Exhibits D, E, F and G. Note also that in Respondent's exemplar of Petitioner's alleged infringement, Pl's Exhibit No. 6 (Request for Admissions, exemplar marked therein as Exhibit C and reproduced at pages 81 and 82 of Record Appendix), two of the six picture postcards (3rd and 4th from the top) are not in their "correct viewing positions".

A.D. 1901. APRIL 19. N° 9023.
HADDAN'S COMPLETE SPECIFICATION. (1 SHEET)



[This Drawing is a reproduction of the Original on a reduced scale]

this country more than one year prior to the filing date of the Tichnor patent.[4] See Record Appendix at page 87.

The Novelty (If Any) of the Tichnor Patent

Postcards *per se* are old, including picture postcards with pictures on one side and printed matter for a message, address, etc., on the reverse side. The assembly of such cards in strips or sheets is old, being shown in Haddan and in Exhibits D, E, F and G. Also, as acknowledged by Tichnor patent (page 4, *supra*) it is conventional during the manufacture of picture postcards to produce them as sheets with graphic illustrations on one side and printed material on the other side. It is also common knowledge that it is old to hang objects such as calendars for display by means of a hole. See the District Court's Opinion at 272 F. Supp. 281, Appendix III at 10a. If there is any novelty in the Tichnor structure it must reside in the following combination of features, each of which taken individually is old:

1. A number of picture postcards having substantially all of the pictures presented to the eye in their correct viewing position.

2. Such postcards being connected together in a strip or sheet but separable from one another.

3. A top panel at one end for the display of advertising material, such top panel having a hole in it for hanging the strip or sheet.

The Summary Judgment of the District Court

Petitioner filed and served a motion for summary judgment under Rule 56, Federal Rules of Civil Procedure. The

---

4. The applicable statute, 35 USC 102(b), renders unpatentable an invention that was "on sale in this country, more than one year prior to the date of application for patent in the United States . . ."

basis of this motion was that the Tichnor structure does not comply with 35 USC 103, which reads as follows:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

The District Court granted the motion on the following grounds:

> "On the basis of Exhibits D, E, F, G and H, I rule that the '304 patent is invalid under the provisions of 35 U.S.C.A. § 103 for lack of invention over the prior art. Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). An examination of plaintiff's alleged invention (Pl. Ex. 2) shows that it consists of nothing more than a glossy cardboard strip divided into six colored postcards, each detachable from the remainder at its perforated edges, together with a short additional strip utilized for the purpose of hanging it on a wall through the medium of an ordinary round hole punched therein. There is no invention in using a punched hole to hang a piece of paper on a wall. The Court will judicially notice that calendars have been affixed to walls for a great many years through the medium of a punched hole in the top portion thereof. There is likewise no invention in having space for advertising material at the top or elsewhere on the strip, since it is a matter of common knowledge susceptible of judicial notice that innumerable calendars, and other cardboard display pieces suitable for wall hanging, such as high and low tide tables, local fire alarm listings, and athletic team

schedules, to name but a few, have had advertising material imprinted on them for a great many years. No expert testimony is necessary to compare the various exhibits before the Court on this motion and to determine the lack of invention, within the meaning of 35 U.S.C.A. § 103, on the basis of which defendant's motion for summary judgment must be granted. George P. Converse & Co. v. Polaroid Corp., 242 F.2d 116, 120 (1st Cir. 1957); Glagovsky v. Bowcraft Trimming Co., 267 F.2d 479 (1st Cir. 1959)." (272 F. Supp. 281); Appendix III at 10a, 11a.

The Reversal by the Court of Appeals

The Court of Appeals characterized the patented structure as one of "provokingly irresistible simplicity". 394 F.2d at 432; 157 USPQ at 660, Appendix I at 2a. The Court of Appeals held, nevertheless, that summary judgment was inappropriate because several advantages were asserted (low cost of manufacture, economic and effective display and servicing by retailers, instant appraisal by the customers); because considerable commercial success was alleged; and because 37 distributors of postcards had in identical affidavits, acknowledged novelty, utility and unobviousness of the invention. See Court of Appeals opinion at 394 F.2d 433, 157 U.S.P.Q. at 660, Appendix I at 2a, 3a.

The Court of Appeals at 394 F.2d 434, 157 USPQ at 662, Appendix I at 5a deemed it

> ". . . not impossible that Colourpicture [Respondent], if allowed to proffer postcard manufacturers and distributors as witnesses, might establish that the simple ideas in the Tichnor patent were not obvious to practitioners in that occupation." (Matter in brackets added)

and that

> "[i]t might also be relevant, in determining obviousness, to see whether and, if so, how the problem met by Tichnor's patent had been treated by others."

In conclusion the Court of Appeals said:

> "Nor is this to say that even the issue of obviousness could not in a proper case be decided by summary judgment. See *Walker v. Gen. Motors Corp.*, 362 F. 2nd 56 (9th Cir. 1966). But we do say that where obviousness is the issue, *Graham* increased the hazards of this route to decision.
>
> "In addition to the stringent requirements governing summary judgment generally and the specific inquiries exacted by *Graham*, the presumptive validity given to patent claims under 35 USC § 282 is also pertinent. We conclude that the district court erred in granting summary judgment under Section 103, noting, however, that nothing we have said here should be interpreted as indicative of the ultimate validity or invalidity of the Tichnor patent." 394 F.2d at 435; 157 U.S.P.Q. at 662; Appendix I at 6a, 7a.

REASONS WHY THE WRIT SHOULD BE GRANTED

1. The decision of the Court of Appeals makes it impossible to obtain summary judgment in a patent suit where the issue is obviousness under 35 USC 103.

The Court of Appeals at 394 F.2d 435, 157 USPQ 662, Appendix I, 6a, concedes that ". . . even the issue of obviousness could—in a proper case be decided by summary judgment," citing *Walker v. General Motors*, 362 F.2d 56, (9th Cir. 1966). Nevertheless, no patent could be simpler than the Tichnor patent and if the prior art were any closer than it is, there would be complete anticipation under 35 USC 101 and 102.[5] Under the rule stated by the Court of Appeals in this case all that any patentee need do to avoid summary judgment on the ground of obviousness under Section 103 is to allege that his invention was

5. 35 U.S.C. 101 requires that the invention be "new" and 35 USC 102 also requires novelty.

not obvious and to obtain *ex parte* statements of several persons to that effect. If the case at bar is not "a proper case" for summary judgment on the ground of obviousness, then there can be no such case.

2. Rule 56 should serve as a check on the propensity of the Patent Office to issue patents without applying the standards set forth in *Graham v. John Deere,* 383 U.S. 1 (1966).

In *Graham,* at 383 U.S. 18, this Court said that it is the primary responsibility of the Patent Office to sift out unpatentable material; that to await litigation is for all practical purposes to debilitate the patent system; and that there is a "notorious difference" between the standards of invention applied by the Patent Office and by the courts. This Court also said in *Graham,* at 383 U.S. 19, that "the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of § 103 . . ."

If ever there were a case where the Patent Office beamed with "laxity" rather than with "intensity" on the requirements of Section 103, it is in this case. In the words of Mr. Justice Douglas, concurring in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.,* 340 U.S. at 156 (1950):

> "The attempts through the years to get a broader, looser conception of patents than the Constitution contemplates have been persistent. The patent Office, like most administrative agencies, has looked with favor on the opportunity which the exercise of discretion affords to expand its own jurisdiction. And so it has placed a host of gadgets under the armour of patents—gadgets that obviously have had no place in the constitutional scheme of advancing scientific

knowledge. A few that have reached this Court show the pressure to extend monopoly to the simplest of devices."

Following this observation the concurring opinion in the *A & P* case sets forth a list of such patented trivia as a door knob made of clay, rubber caps on pencils as erasers, etc., and following this catalogue of patented trivia the concurring opinion refers to the "incredible patents which the Patent Office has spawned." 340 U.S. at 156-158.

It is apparent from the present case that some segments of the Patent Office persist in ignoring the admonitions of this Court and continue to spawn incredible patents on trivial devices.[6] The issuance of such patents places a heavy burden upon the public and upon competitors to defend expensive and protracted patent litigation.[7] The most practical and speedy remedy for this lax practice of the Patent Office and the burden it places on the public is to apply Rule 56. Moore's Federal Practice, 2nd Ed., Vol. 6, pages 2613-2617 states the general rule, which has been universally accepted until the present case, that summary judgment is appropriate in patent cases including cases where the issue is obviousness, and that summary judgment is on no different footing in such cases than in others. The general purpose of Rule 56 is described by the same authority at Section 56.04[1], page 2057 as a "procedural device for promptly disposing of actions in which there is no genuine issue as to any material fact."

The effect of the decision of the Court of Appeals in this case is to withdraw the test of obviousness from the

---

6. The Tichnor patent application was filed and prosecuted after the *Graham* decision.

7. According to Mayer, "The Lawyers", pp. 400-401, patent infringement trials are very costly. Present counsel for Petitioner aver that $25,000 is a very modest cost of trying a patent case. Additionally, Respondent has engaged and is presently engaged in a publicity campaign hailing the Court of Appeals decision as a victory. Specimens of such publicity are reproduced in Appendix IV.

reach of Rule 56 and to require trial of all patent cases where the issue is obviousness. The function of Rule 56 is, therefore, perverted.

3. The impact of *Graham* on Rule 56 was misconstrued by the Court of Appeals.

The Court of Appeals read into *Graham* a requirement that allegations of unobviousness must be tried and cannot be disposed of by a motion for summary judgment under Rule 56 supported by stipulated items of prior art. The Court of Appeals said that *Graham* ". . . increased the hazards of this [Rule 56] route to decision" and that, in addition to the general requirements of Rule 56 ". . . specific inquiries are exacted by *Graham*". 394 F.2d at 435; 157 U.S.P.Q. at 662, Appendix I at 6a, 7a.

In *Graham,* at 383 U.S. 17, this Court pointed out that the scope and content of the prior art are to be determined, differences over the prior art are to be ascertained and the level of skill is to be resolved and that such secondary considerations as commercial success, long felt but unsolved needs and failure of others might be utilized to shed light on the subject. This Court did not, however, lower the standard of invention when attacked by summary judgment under Rule 56. On the contrary, at 383 U.S. 19 this Court said:

> "We have been urged to find in § 103 a relaxed standard, supposedly a congressional reaction to the 'increased standard' applied by this Court in its decisions over the last 20 or 30 years. The standard has remained invariable in this Court. Technology, however, has advanced—and with remarkable rapidity in the last 50 years. Moreover, the ambit of applicable art in given fields of science has widened by disciplines unheard of a half century ago. It is but an evenhanded application to require that those persons granted the benefit of a patent monopoly be charged with an aware-

ness of these changed conditions. The same is true of the less technical, but still useful arts. He who seeks to build a better mousetrap today has a long path to tread before reaching the Patent Office."

The plain meaning of this is that the Constitutional standard of invention remains invariable. This meaning has been distorted by the Court of Appeals to mean that the standard of invention is relaxed to the vanishing point for purposes of summary judgment.

4. The decision of the Court of Appeals is in conflict with cases in the Ninth, Second and Third Circuits as to the effect of *Graham* on Rule 56 in Section 103 cases.

In *Walker v. General Motors*, 362 F.2d 56 (9th Cir. 1966) the propriety of summary judgment under Rule 56 as to obviousness was squarely raised. The Court of Appeals for the Ninth Circuit held (citing *Graham*) that summary judgment is appropriate and that, as regards the factual background needed for a judgment, "a summary judgment invariably rests on a factual foundation". 362 F.2d at 59. This rule was followed and *Walker* was cited in another Ninth Circuit case, *Alladin Plastics, Inc. v. Jerrold Stephan Co.*, 362 F.2d 532 (9th Cir. 1966).

Monoplastics, Inc. v. Caldor, Inc., 378 F.2d 20 (2nd Cir. 1967) is to the same effect.

> "Appellant suggests that the summary judgment motion should not have been granted without the taking of testimony from experts in the pertinent area of knowledge. We agree, however, with the court below that the three-piece plastic towel rack patented by Mayer when combined with integral molded-in polypropylene plastic hinges to make the Monahan one-piece plastic towel rack did not create a patentable invention for the resulting device would have been obvious to

> persons having ordinary skill in the plastics molding industry, and would even have been obvious to ordinary laymen of modest intelligence. Under these circumstances the court had no need for expert testimony in order to examine the nature of the prior art or the level of skill in the relevant industry. Therefore summary judgment was properly granted." 378 F.2d at 21.

This opinion does not refer specifically to *Graham*, but it cites *Walker, supra*, for the rule given in the excerpt above.

Allen-Bradley Co. v. Air Reduction Co., 391 F.2d 282 (3rd Cir. 1968) affirmed a summary judgment in a *per curiam* opinion. The Court of Appeals for the Third Circuit used the following language:

> "In our view, the structures involved seem so simple, the role and functions of the device and its several components so clear and normal, and the opposing contentions of the parties so understandable, that no useful function would have been served by testimony concerning obviousness by persons claiming special skill in mechanics or experience in dealing with the problems of packaging this device solved." 391 F.2d at 283.

CONCLUSION

It is respectfully submitted that the writ should issue.

EDWARD B. GREGG
Attorney for Petitioner

Of Counsel

LIPPINCOTT, GREGG, HENDERSON & STIDHAM.
KENWAY, JENNEY & HILDRETH
WILLIAM G. MACKAY
PAUL L. MAY